

CASE NO.: 1173.001  
Serial No.: 09/665,368  
January 27, 2004  
Page 2

PATENT  
Filed: September 19, 2000

computer communicating over a wide area network as alleged in the rejection, but nowhere does Hess et al. teach that the thumbnails may represent "models". Instead, what Hess et al. actually teaches at col. 7, line 61-col. 8, line 30 (alleged to be a teaching of providing files representing models) is merely that files representing *images* of items to be sold may be downloaded, not that the files represent "models". In fact, apart from twice mentioning a "client-server model" to refer to its system architecture, Hess et al. nowhere mentions the word "model", and clearly not as a type of item to be vended.

To the extent that the examiner is construing the thumbnail images of Hess et al. as being the claimed "model" under the guise of broad claim interpretation during prosecution, the examiner is reminded that MPEP §2111.01 does not permit *any* broad interpretation to be accorded to a claim term, but rather *only* those interpretations that would be accorded by the skilled artisan. Accordingly, evidence is hereby seasonably requested to be made of record that, to the skilled artisan, thumbnail images are synonymous with "models". Otherwise, the rejection must fall for relying on a claim term interpretation that is not supported by evidence of record as being one that is used, as is required by the MPEP, by the skilled artisan.

In any case, what is downloaded when the user clicks on a thumbnail image in Hess et al. is not the advertised item itself, but rather information about the item. Contrast this to Claim 1, for instance, which requires that a user not only access a model page, but also print a data file from the page that is useful for causing a computer printer to print a substrate having model indicia thereon, with the model indicia in turn being useful for configuring the substrate into a paper model. The rejection alleges that this limitation is taught by Hess et al. at col. 3, lines 24-29 and col. 8, lines 29-54, but this is a misrepresentation of what Hess et al. actually teaches, which is simply that thumbnails of various image formats may be downloaded.

1173-1.AMD

CASE NO.: 1173.001  
Serial No.: 09/665,368  
January 27, 2004  
Page 3

PATENT  
Filed: September 19, 2000

Nothing in Hess et al. mentions "models", much less that what is downloaded when a user clicks on a thumbnail is a file that can be used as set forth in Claim 1.

This deficiency in the rejection is important because an accurate portrayal of what Hess et al. teaches makes evident that combining Matos with Hess et al. does not result in the present invention. Instead, all the proposed combination would result in would be downloading *information* about Matos' model to a user, not downloading a data file that would be useful, as required in Claim 1, to configure a paper substrate into an actual model. Accordingly, the proposed combination would not arrive at, e.g., Claim 1, rendering the *prima facie* case defective under the MPEP.

Second, the proposed combination lacks the requisite prior art suggestion and thus is traversed on this additional ground, see, e.g., MPEP §2143.01 (the mere fact that a reference can be modified does not render an invention obvious, unless the modification is suggested by the prior art, citing In re Mills). As divulged above, Hess et al. nowhere envisions paper models, so it cannot provide the motivation to use Matos. Matos teaches folding picture puzzles but nowhere mentions how they may be obtained, much less does Matos suggest obtaining them over a wide area network.

Sensing that providing a rationale for combining two references is required but evidently unaware of the constraint that the rationale must come from the prior art, the rejection alleges that the proposed combination is proper simply because "Matos' paper model would improve images of Hess' system by folding the pieces of paper to construct a three dimensional image structure", Office Action, paragraph 4. Apart from springing from the imagination of the examiner and not from the prior art, this rationale, as far as it is comprehensible, appears to be based on a *non-sequitur*. How, precisely, does a foldable paper model improve a computer thumbnail image? What is the mode of improvement by which the proposed cooperation

1173-1.AMD

CASE NO.: 1173.001  
Serial No.: 09/665,368  
January 27, 2004  
Page 4

PATENT  
Filed: September 19, 2000

of paper with electronic images operates? Why, precisely, would eBay need to provide foldable paper models to communicate the intended product information to a Web surfer? The rejection falls because there exists no prior art reason to combine Matos with Hess et al.

The rejections of certain dependent claims likewise fail to properly establish a *prima facie* case of obviousness under the MPEP. For instance, by way of non-limiting example and conceding nothing about the propriety of the rejections of other claims, Claim 11 has been rejected because Matos allegedly teaches assembly instructions at col. 17, line 55-col. 18, line 18, but this is incorrect. The relied-upon section of Matos does not teach printed assembly instructions, but rather "encoded image portions". Further, Claims 2 and 11 do not recite "assembly instructions" in a vacuum but rather that the instructions be provided from the downloaded data file, something that Matos nowhere envisions since it does not contemplate how the picture puzzles, much less assembly instructions, are provided in the first place.

It is alleged that Hess et al., col. 7, lines 14-27 teaches the limitations of Claims 12-14. This is incorrect. The relied-upon section of Hess et al. teaches that a buyer can select payment and shipping methods, not that accounting data is generated when the buyer accesses the Web page (Claims 12 and 14) or when the buyer prints a download (Claim 13). According to Hess et al. accounting data is generated only when the buyer actually makes a purchase of a product.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

1173-L.AMD

CASE NO.: 1173.001  
Serial No.: 09/665,368  
January 27, 2004  
Page 5

PATENT  
Filed: September 19, 2000

Respectfully submitted,



---

John L. Rogitz  
Registration No. 33,549  
Attorney of Record  
750 B Street, Suite 3120  
San Diego, CA 92101  
Telephone: (619) 338-8075

JLR:jg

1173-1.AMD